



001.00301

THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Citovsky et al.	)	
		)	
Serial No.:	09/435,274	)	Examiner: D. Lamberston
		)	
Filed:	November 5, 1999	)	Art Unit: 1636
		)	
For:	GENETIC ASSAY FOR PROTEIN	)	
	NUCLEAR TRANSPORT	)	

---

### REQUEST FOR RECONSIDERATION

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

Applicants request reconsideration of the outstanding office in view of the following remarks.

Applicants acknowledge acceptance of the drawings.

The rejection of claims 1-33 and 35 under 35 U.S.C. § 102(a) as anticipated by WO98/49284 to Ueki et al. ("Ueki") is respectfully traversed because the present invention was reduced to practice prior to the effective date of Ueki.

As set out in the Declaration Under 37 CFR § 1.131 attached hereto ("Declaration"), Ueki was filed as International Application PCT/JP98/01936 on April 27, 1998 and published on November 5, 1998. (Declaration ¶ 3). Accordingly, the available effective date of Ueki as a reference against the above-identified patent application is November 5, 1998. (Id.) The above-identified patent application was filed on November 5, 1999, claiming priority to U.S. Provisional Patent Application No. 60/107,417, filed on November 6, 1998. (Declaration ¶ 4) The invention covered by the claims of the above-identified patent application was reduced to practice before November 5, 1998 (i.e. prior to the effective date of Ueki). (Declaration ¶ 5). As evidence of the reduction to practice, is a letter from the assignee of the above-identified patent application (The Research Foundation of State University of New York; recorded at Reel/Frame

010704/0024) forwarding a description of the invention to an attorney for review prior to filing with the U.S. Patent and Trademark Office. (Declaration P 6). The date of this letter was prior to November 5, 1998. (Id.) The documentation covering the invention was submitted under cover of the letter dated prior to November 5, 1998. (Declaration P 7). This disclosure was ultimately filed as U.S. Provisional Patent Application Serial No. 60/107,417 on November 6, 1998. (Id.) This disclosure related to a construct (chimeric nucleic acid) which expresses a fusion protein for use in an assay for nuclear transport and a host cell and vector which includes the chimeric nucleic acid encoding the fusion protein, and a modified LexA protein having no nuclear localization signal. (Declaration P 8).

Accordingly, because the invention was reduced to practice prior to the effective date of Ueki, the rejection is traversed (Manual of Patent Examining Procedure 715.01.

Applicants believe that the present case is in condition for allowance and such allowance is respectfully requested.

Respectfully submitted,

September 17, 2003

Date

Karla M. Weyand

Karla M. Weyand

Registration No. 40,223

Rogalskyj & Weyand, LLP  
PO Box 44  
Livonia, New York 14487-0044  
Telephone (716) 626-5380  
Telefax (716) 626-5384

Certificate of Mailing-37 CFR 1.8(a)  
I hereby certify that this  
correspondence is being deposited  
with the United States Postal Service  
as first class mailing an envelope  
addressed to : Commissioner for Patents,  
PO Box 1450, Alexandria, VA 22313-1450,  
on the date below.

9/17/03  
Date

Karla M. Weyand  
Karla M. Weyand